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ROSS PRODUCTS DIVISION OF ABBOTT LABORATORIES
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EXAMINER	
PRATT, HELEN F	

ART UNIT	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/603,464
Filing Date: June 25, 2003
Appellant(s): NDIFE ET AL.

William J. Winter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9-27-04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-11 and 14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,241,975	BROCHNER	3-1966
WO03077664	OZALVO	9-2003
3,608,064	LAMB	9-1971
4,894,236	JANG ET AL.	1-1990

OnlineConversion.com (Pressure Conversion)

Merck Index, page MISC-87.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-11and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brochner (GB 894,001) in view of Ozalvo et al. (WO 03/077664 A1). The references to Jang, Lamb, Merck and Online conversion are used to give support for conversion of tons to PSI.

Brochner discloses a milk tablet, which contains protein, carbohydrate and fat in the claimed amounts (page 1, lines 80-90). Claim 1 differs from the reference in the amount of time that it takes for the tablet to dissolve. However, it is seen at this time that the tablet dissolves in the claimed amount of time because the composition is the same. Applicants admit that various known baby formulas can be used (page 3, lines 12-15, page 5, lines 28-35, pages 6 - 8) and that tabulating procedures are known (page 11, lines 20-35). Also, Ozalvo et al. disclose that it is known to make a tablet from baby formula, which readily dissolves in water (abstract and page 11, lines 3-5). Nothing is seen at this time that the compressing weight of 0.25 tons would not provide a tablet that would dissolve in 60 seconds. Therefore, it would have been obvious to substitute other dry milk type formulas such as baby formula for the milk formula of the reference particularly since the amounts of ingredients are the same.

Claims 1 and 14 further require a particular psi of from 400 to 1500. However, Ozalvo et al. disclose a compressing weight of 0.25 tons, which multiplied by 2000 tons,

gives a psi (lbs per square inch) of 500, which is within the claimed range (Merck Index conversion table). Lamb discloses that the unit of measure for "tons" in tablets is "tons per square inch (col. 2, line 16). Jang et al. disclose the same (abstract). "On line conversion" discloses that 0.25 tons equals 560 PSI (page 1). These last 3 references are used to show that 0.25 tons is equal to 560 PSI, which is within the claimed range for pressure. The degree of pressure would have kept the tablet from forming a film of oil or fat on the tablet since the claimed composition and pressure have been shown. Therefore, it would have been obvious to use a known compressing weight in the process of Brochner as shown by Ozalvo et al. who makes a tableted baby formula.

Claims 2-4 further require particular amounts of protein, fat and carbohydrate, which are still within the claimed ranges of Brochner (page 1, lines 80-90). Therefore, it would have been obvious to make a baby formula as claimed.

Claims 5-10 further require particular ingredients in the composition. However, as applicants say that these compositions are known, as above, the compositions would contain the particular ingredients. Therefore, it would have been obvious to use known ingredients in the claimed compositions.

Claim 11 further requires dissolving the tablet and feeding the resulting formula to the infant. The claimed composition has been disclosed above. If the composition is for feeding infants, then it would have been obvious to dissolve the tablet in water and feed it to an infant as that is the intended use of the tablet. Therefore, it would have been obvious to use known baby formulas in tablet form to feed to an infant.

The further limitations of claim 14 have been disclosed above and are obvious for those reasons.

(11) Response to Argument

Appellants argue that the references do not show that selecting a pressure so that a film of fat does not form on the exterior of the tablet. The Appellants argue that this is important because the film of fat on the exterior of the tablet keeps the tablet from dissolving quickly, i. e. in 60 seconds. Therefore, claims 1 and 14 are in part to selecting a pressure for tableting which does not cause the oil to form a film of fat on the surface of the tablet. However, a tableting pressure within the claimed range has been shown by Ozalvo et al. (abstract and page 11, lines 3-5). In the first office action, the Examiner made the statement that "nothing has been shown that compressing weight of 0.25 tons would not provide a tablet that dissolves in 60 seconds". Dissolving in this amount of time using the disclosed pressure would mean that there was not enough oil exuded at that pressure to keep the tablet from dissolving in 60 seconds. The limitation that the "pressure is selected so that a film of fat does not form on the surface of the tablet" is functional language. This limitation is seen to have been within the skill of the ordinary worker to control as a tablet with such a film would not have been marketable. Oil is known to become rancid in time and to discolor thereby producing an unacceptable product. Although Ozalvo does not address the limitation in the reference that an oily film occurs at the pressure of 0.25 tons, nothing has been shown that it would have. The claimed composition has been shown and an amount of pressure

within the claimed amount. "Selecting the pressure..." is seen to have been a process limitation in a composition claim.

Appellants argue that the pressure of 0.25 tons disclosed by Ozalvo et al. in view of Merck does not show their pressure and that the conversion is incorrect. This is not seen because Merck distinctly discloses tons converted to psi. As before, 0.25 tons x 2000 tons = a psi of 500 (final office action, page 2). To support this conversion, Jung et al. disclose a lipid containing tablet to which a pressure of 1.5 to 20 tons per square inch (abstract) is applied, and Lamb discloses the measurement "tons per square inch" (col. 2, line 16). Tons per square inch shows that this is the usual measure known in the art for pressing tablets. "On line conversion" discloses that 0.25 tons-force/square inch = 560 pound-force/square inch (psi). These amounts, 500 and 560 are within the claimed range. Therefore, a tableting pressure within the claimed range has been shown by the combined references and nothing has been shown that there was any problem with an oil film, which would have kept the tablet from dissolving in 60 seconds if a pressure of 0.25 tons were used. The references may not state in so many words the problem of tablet dissolution when there is a film of oil, but the claimed composition has been shown using the claimed pressure, and nothing has been shown that there is an oily film on the product.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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November 15, 2004

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